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| GOODWIN PROCTER LLP | | | | |
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| EXAMINER | | | | |
| McCORMICK, GABRIELLE A | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3629 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/712,076

Applicant(s)

FAWCETT ET AL.

Examiner

Gabrielle McCormick

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD/IC)
- Paper No(s)/Mail Date 11/13/03; 12/27/04; 3/21/05; 1/22/07

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on November 13, 2003.
2. Claims 1-38 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statements filed November 13, 2003, December 27, 2004, March 21, 2005 and January 22, 2007 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 33 contains the terms, "the rules", which lacks proper antecedent basis.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
7. Claims 1-27 are rejected as being directed to non-statutory subject matter. Claim 1 is a method claim that recites process steps that are not tied to a particular machine. Based on recent Federal Circuit decision (see *In re Bilski*), an applicant may show that a process claim satisfies 35

USC 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. (See Benson, 409 U.S. at 70). First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. (See Benson, 409 U.S. at 71-72). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-resolution activity. (See Flook, 437 U.S. at 590).

8. Claim 1 does not recite the use of any machine implementation, rather, it recites method steps that can be implemented by a human being.
9. Because the applicable test to determine whether a claim is drawn to a patent-eligible process under 35 USC 101 is the machine-or-transformation test set forth by the Supreme Court, claim 1 fails that test and is therefore rejected under 35 USC 101. Claims 2-27 are rejected through dependency from claim 1.
10. Claims 28-36 are rejected under 35 U.S.C. 101 because they lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 36 USC 101. They are clearly not a series of steps or acts (i.e., a process) not are they a combination of chemical compounds (i.e., composition of matter). As such, they fail to fall within a statutory category. They are, at best, function descriptive material *per se*.
11. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, (33 F.3d at 1360, 31 USPQ2d at 1759). When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).
12. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm

in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. **Claims 1, 15-16, 21-22, 28-30 and 37** are rejected under 35 U.S.C. 102(e) as being anticipated by Pope et al. (US Pub. No. 2003/0131013, hereinafter referred to as "Pope").
15. **Claims 1, 28 and 37:** Pope discloses database management programs and spreadsheet applications that allow users to set up (i.e., specify and define) meaningful organizational structures for information (i.e., a system for storing and retrieving information) where users make and view links to resources from within the application. (i.e., associate information) (P[0014]) and users enter information about documents (P[0019]; thus receiving information). Hierarchical relationship structures indicate relatedness between information units (P[0015]) that are defined by the user. (P[0016]; thus relationships between topics are specified). As a user focuses on a current task (i.e., second topic information) the system make related entities accessible. (i.e., user receives first topic information). (P[0052 and 0055]). An explicit request from the user can trigger information retrieval. (P[0121]). Additional information (i.e., first topic information) is displayed concurrently with second topic information (P[0124]).
16. **Claims 15, 16 and 29:** Pope discloses emails as sources of information. (P[0153]).

17. **Claims 21 and 22:** Pope discloses implementing the system on networked devices, therefore, it is inherent that a server would provide storage. (P[0175]).
18. **Claim 30:** Pope discloses database management. (P[0014]).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. **Claims 2-14 and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pope et al. (US Pub. No. 2003/0131013, hereinafter referred to as "Pope") in view of Hoovers (documents retrieved from the Internet Archive at <http://web.archive.org/web/20001021183850/hoovers.com/industry/description/0,22052320...> and <http://web.archive.org/web/20001010055534/hoovers.com/co.capsule/7/0,2163,1000700.ht...>).
21. **Claims 2 and 6-13:** Pope discloses the method of claim 1 but does not disclose descriptions of topics and relationships.
22. Hoovers, however, discloses industry, company, subsidiaries/divisions, indices, competitors, customers and topics.
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included specific descriptions of topics and relationships, as disclosed by Hoovers in the system disclosed by Pope, for the motivation of providing a method of customizing the database management system of Pope to a specific business research need.
24. Hoovers does not disclose a licensor-licensee relationship, however, this description, as well as the above cited descriptions are **nonfunctional descriptive data** and are not functionally involved in the steps recited. **The retrieval of related information would be performed**

regardless of the description of the topic or relationship. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

25. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included specific descriptions of topics and relationships because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation descriptions does not patentably distinguish the claimed invention.
26. **Claims 3-5 and 32:** Pope does not disclose unidirectional and bi-directional relationships.
27. Hoovers, however, disclose unidirectional (Industry – Company; Company – index) and bi-directional (company - competitors) relationships.
28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included specific descriptions of relationships, as disclosed by Hoovers in the system disclosed by Pope, for the motivation of providing a method of customizing the database management system of Pope to a specific business research need.
29. **Claim 14:** Pope discloses that relationships between entities can be defined or explicitly declared, but does not explicitly disclose providing a description of the relationship.
30. Hoover's discloses related topics such as "Subsidiaries/Divisions", thus disclosing a description of a relationship based on subsidiaries and divisions of a company.
31. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included providing a description of the relationship, as disclosed by Hoover's, in the system of Pope for the motivation of providing a method of customizing the database management system of Pope to a specific business research need.
32. **Claims 17-20; 23-27, 31, 33-36 and 38** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pope et al. (US Pub. No. 2003/0131013, hereinafter referred to as "Pope") in view of Henderson et al. (US Pub. No. 2003/0009536, hereinafter referred to as "Henderson").

- 33. Claims 17-20; 23-27, 31, 33-36 and 38:** Pope discloses that relationships change over time (P[0005]), that one individual's activity is linked to the interactions of others who collaborate with and share information (P[0007]) and updating organizational structures. (P[0017]). Pope also discloses that forms can be used to capture access points of the specific type or format required by the system for indexing (P[0020]) where these enterprise-wide systems require participation of all or most users. (P[0021]). Pre-selected and pre-grouped sets of information may be created by the user, generated by a party other than the user, or some combination of these. (P[0035]). Thus, the collaborative nature of maintaining the organizational structures by various users discloses both a first and second user capable of associating information and modifying relationships. Further, as the system is deployed enterprise-wide, a second user will receive the first topic information.
- 34.** Pope does not explicitly disclose how collaboration transpires, thus does not explicitly disclose the role of various users with respect to modification, requests and transmission of data and access privileges. Pope discloses hierarchical relationship structures to indicate relatedness (P[0015]), thus disclosing the functionality of a rules engine for governing the relationships, but does not explicitly disclose a rules engine.
- 35.** Henderson, however, discloses a collaborative knowledge management system using a database server for storage, relationships (associated with a set of rules), (i.e., a rules engine) to associate data objects and rules to define user privileges (P[0017]). The invention uses networked computers to collaborate, save, retrieve, form and share knowledge (P[0035]), thus disclosing that various users have the capability to retrieve, form and share knowledge. A messaging component receives and transmits data (P[0056]). The system allows a large number of users to access a single information repository to edit, store and retrieve content. (P[0064]). Users edit documents asynchronously. (P[0067]). Users retrieve data (P[0064]), therefore updated data is provided to the user upon request. CKMS provides real-time updating, therefore users edit and review the latest information. (P[0069]). Content security (i.e., access privileges) is dependent on the user and the content profile. (P[0075]).

36. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included the details of groupware works, as disclosed by Henderson, in the system of Pope because Pope discloses a collaborative environment and states "an individual's activity may also be linked to the activities of others, who may be collaborating with the individual and sharing the same or overlapping foci to varying extents." (P[0007]). Henderson states that "Systems and methods generally directed to collaboration, knowledge management and groupware systems are known." (P[0002]). Therefore, the combination of Henderson with Pope is both predicted by Pope and known in the art, thus the combination would merely result in the combination of old elements and in the combination, each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629